

REMARKS

Claims 1 - 23 are pending in the application. Claims 1 and 9 have been amended. Claim 5 has been cancelled. Claims 15 and 16 have been cancelled as being drawn to non-elected subject matter. New claim 24 has been added. No new matter has been added by virtue of the amendments and claims, support being found throughout the specification and claims as originally filed.

Any cancellation of the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Sequence Rules

The Examiner argues that "this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reasons set forth on the attached Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/or Amino Acid Sequence Disclosures." (Office Action, p.2).

Applicants submit herewith a nucleotide and/or amino acid sequence disclosure in compliance with the requirements as set forth in 37 CFR 1.821 through 1.825.

Applicants respectfully request that the Examiner reconsider and withdraw the foregoing rejection.

Rejection of Claims 5 and 9 Under 35 USC 112, Second Paragraph

The Examiner has rejected claims 5 and 9 under 35 USC 112, second paragraph as being indefinite. Applicants respectfully traverse the rejection.

The Examiner argues that "claim 5 is indefinite in that the type and degree of correspondence is unclear." (Office Action, p.3).

Applicants have cancelled claim 5.

Applicants respectfully request withdrawal of the rejection and allowance of the claims.

The Examiner argues that “claim 9 is indefinite in that the phrase ‘at least a lower level’ is awkward and therefore confusing.” (Office Action, p.3).

The Examiner indicates that “(a)mending this claim to read ‘at least at a lower level’ will overcome this portion of the 112, second paragraph rejections.” (Office Action, p.3). Accordingly, Applicants have amended the claims as suggested by the Examiner to recite the limitation “at least at a lower level.”

Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Rejection of Claims 1- 9 and 17 - 23 Under 35 USC 102(b)

The Examiner has rejected claims 1 – 9 and 17 – 23 under 35 USC 102(b) as being anticipated by Goggins et al. (WO 02/068694). Applicants respectfully traverse the rejection.

Instant claim 1 recites a method for diagnosing cancer, comprising the detection of a methylated SPARC nucleic acid molecule or a variant thereof in a sample from a subject, wherein the methylated SPARC nucleic acid molecule comprises a sequence corresponding to the nucleic acid sequence set forth in SEQ ID NO: 1 (Figure 6).

In order for a reference to anticipate the pending claims, the reference must teach each and every element that is set forth in the claims, either expressly or inherently (see, *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987) and *MPEP* 2131).

Nowhere does the Goggins et al. (WO 02/068694) reference, expressly or inherently, teach or describe a method for diagnosing cancer, comprising the detection of a methylated SPARC nucleic acid molecule or a variant thereof in a sample from a subject, wherein the methylated SPARC nucleic acid molecule **comprises a sequence corresponding to the nucleic acid sequence set forth in SEQ ID NO: 1** (Figure 6). Applicants direct the Examiner’s attention to Table 1 of the Goggins reference, which clearly sets forth the identified differentially methylated sequences.

Based on the foregoing; Applicants submit that the claims are not anticipated by Goggins et al.

Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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Respectfully submitted,

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